

REMARKS

Claims 1-20 are all the claims pending in the application.

Claim Objections

The Examiner objected to claim 2 for a minor informality. Applicants request that the Examiner withdraw this objection in view of the self-explanatory amendment to claim 2.

Claim Rejections - 35 U.S.C. § 102(b) - Fernandez (1998)

The Examiner rejected claims 1-3, 5-7 and 20 under § 102(b) as being anticipated by Fernandez (1998). Applicants traverse this rejection as follows.

First, Applicants submit, consistent with the remarks set forth in the June 2, 2006, Amendment, that the Examiner is attempting to combine the features of three independent programs (different embodiments) that run in the Windows environment to improperly reject these claims under § 102. However, it is well settled that different embodiments may not be combined absent a suggestion to do so. *Ex parte Beuther*, 71 USPQ2d 1313, 1316 (BPAI 2003); *In re Arkley*, 455 F.2d 586, 587-588, 172 USPQ 524, 526 (CCPA 1972). Because no suggestion for combining these different software components exists within this or any other reference provided by the Examiner, the rejection by the Examiner is invalid. Additionally, the Examiner has failed to provide any suggestion to combine these embodiments.

In the Response to Arguments portion of the present Office Action, the Examiner cites *Verdengaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987) for the proposition that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. (Office Action, p.

6) Applicants submit that this case does not mean that a claim is anticipated where the Examiner combines the features of three different independent programs.

In particular, it is well settled “that anticipation is not established if in reading a claim on something disclosed in a reference it is necessary to pick, choose, and combine various portions of the disclosure not directly related to each other by the teachings of the reference. (See *Ex parte Beuther*, 71 USPQ at 1316 citing *In re Arkley*, 172 USPQ 524, 526 (CPA 1972)). The Examiner attempts to brush off the importance of this case by merely stating that this case and the instant application have different fact patterns. Applicants respectfully disagree.

Specifically, in *Beuther*, the issue is the specific properties associated with a single product, i.e. “tissue.” (*Beuther*, 172 USPQ at 1315). Moreover, the specific tissue is relegated to only embodiments of “layered tissue paper having a velutinous surface subjectively discernable by humans as being extremely soft and smooth, and to tissue paper products comprising one or more plies of such paper.” (*Id.*). The reference applied by the Examiner in *Buether* discloses several embodiments of tissue meeting this narrow criteria yet the Federal Circuit held that the various embodiments were not directly related even though they were all in this narrow class of tissue that appear to be closely related. (*See id.*).

In contrast to this strict standard for determining whether various embodiments are directly related, the Examiner merely concludes that because the applications are capable of functioning under a single operating system, one of skill in the art would have understood that the applications are directly related. (Office Action, p. 7). Applicants submit that the Examiner’s position is unsupported and, further, contradicts the standard for determining whether

embodiments are directly related as set forth in *Beuther*. As evidenced by the above fact pattern, the criteria for determining whether two products in such narrow field are directly related is extremely strict in application.

Moreover, according to the Examiner's application of the law to fact, because of the dominance of the Windows operating system, any catalog of software would imply that any of the products therein are directly related. Applicants propose that because the field of applications capable of running on windows related to multimedia files is much broader than the range of tissues comprising "layered tissue paper having a velutinous surface subjectively discernable by humans as being extremely soft and smooth, and to tissue paper products comprising one or more plies of such paper," that the Examiner's position that the windows application are directly related is wholly unsupported. (*Id.*)

Finally, because the Examiner's picking and choosing of different features from different software components (applications) that may run under the Windows operating system is in contravention of well-established caselaw, Applicants submit that this rejection is in error and should be withdrawn.

Thus, Applicants submit that claims 1-3, 5-7 and 20 are allowable for at least this reason.

Second, even if the Examiner could pick and choose between the various embodiments in an anticipation rejection under § 102, Applicants submit that Fernandez fails to disclose, at least, a display driving unit that displays the search window and the edit window together in a single display screen, as recited in claim 1.

The Examiner alleges that Fernandez discloses this feature citing page 61 and another reference *SMS Teach Yourself Windows 98 in 24 Hours*, Greg Perry (Sams Publishing 1998) to show inherency.

In contrast to the Examiner's contention, Applicants submit that page 61 of Perry fails to disclose displaying an edit window or a search window and, further, fails to disclose that these windows are displayed at the same time. However, the Examiner alleges that Perry discloses the displaying of the search window and the edit widow together (multiple windows) in a single display screen as an inherent feature of the Windows operating system.

To the contrary, Applicants submit that even if Fernandez does disclose both a search window and an edit window, the reference fails to disclose them displayed together in a single display because the Examiner has failed to prove inherency.

The question of whether a claim limitation is inherent in a prior art reference is a factual issue. See, *Continental Can Co.*, 948 F.2d at 1268. The doctrine of inherency allows for "modest flexibility in the rule that 'anticipation' requires that every element of the claims appear in a single reference." *Id.* at 1269. "It is not, however, a substitute for determination of patentability in terms of § 103." *Id.* Although extrinsic evidence may be consulted regarding an asserted inherent characteristic, "[s]uch evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *Id.* at 1268 (emphasis added). Moreover, inherency "may not be established by probabilities or possibilities." *Id.* at 1269. "The mere fact that a certain thing may result from a given set of circumstances is not sufficient," and expert testimony cannot be used to fill in the

evidentiary gaps of an otherwise lacking prior art reference. *Motorola Inc. v. Interdigital Technology Corp.*, 121 F.3d 1461, 1473 (Fed. Cir. 1997), citing *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554 (Fed. Cir. 1983) (reversing trial court's judgment of invalidity because expert's testimony of inherent anticipation, unsupported by the evidentiary record, cannot serve as a basis for a finding of anticipation).

Here, the Examiner merely cites a reference that discloses that multiple windows may be displayed at the same time. (*See Perry*, at p. 42) However, this disclosure does not support the Examiner's position that the alleged search window and edit window of Fernandez are displayed in a single display screen. At most, this reference supports that the search window and edit window may be displayed at the same time. This merely establishes a possibility that the windows may be displayed at the same time. Because, *Continental* clearly holds that a mere possibility does not establish inherency, this reference does not establish inherency as alleged by the Examiner. Thus, Fernandez fails to disclose a display driving unit that displays the search window and the edit window together in a single display screen.

Thus, Applicants submit that claim 1 is allowable for at least this additional reason. Additionally, Applicants submit that claims 2-3 and 5-7 are allowable at least because of their dependency.

Regarding claim 20, because this claim recites displaying the search window and the edit window together in a single display screen, a feature similar to that discussed above with regard to claim 1, Applicants submit that claim 20 is allowable for the same reasons set forth with regard to claim 1.

Claim Rejections - 35 U.S.C. § 102(a) - Rodriguez et al.

The Examiner rejected claims 1-6, 8-10, 12-16 and 18 as being anticipated by Rodriguez et al. (2003/0005454; Rodriguez). Applicants traverse this rejection as follows.

Claim 1 recites, *inter alia*, a display driving unit that displays the search window and the edit window together in a single display screen.

The Examiner alleges that Rodriguez discloses displaying both a search window and an edit window in a single display screen citing Figures 5, 6 and 8-14 of Rodriguez. Further, the Examiner denotes the “Edit/Search Screen” portion of these screens with particular emphasis.

However, in contrast to the Examiner’s reading of Rodriguez, Applicants submit that Rodriguez does not disclose displaying both a search window and an edit window in a single display screen. In particular, the windows referred to by the Examiner include archive main screens (FIGS. 5, 6 and 8-11); edit screens (FIGS. 12 and 13); and a search screen (FIG. 14). Notably, none of these displays includes both an edit window and a search window. To the contrary, FIGS. 13 and 14 provide support that these are not displayed in a single screen, rather, they are displayed in separate screens.

Additionally, the Examiner also seems to reference the “Edit/Search Screen” (button “B”) at the bottom of screens 5, 6 and 8-11 to disclose this feature of claim 1. This button is described at the end of paragraph [0085] of Rodriguez, which indicates that “the user may decide to search or edit prior configurations by selecting the “B” edit/search screen button 1142. However, this portion does not disclose that a search window and an edit window are displayed in a single display screen. Rather, this is merely a step that a user must take in order to access the edit or

search window. Rodriguez is clear that the edit screen 1200 (*see* FIGS. 12 and 13) is displayed first after the button “B” is selected. Then, after “B” is selected and the edit window 1200 is shown, the user may select button “A: Search” to change the display to display the search window 1400. (par. [0086-0087]). Nowhere is it illustrated or disclosed that the search window 1400 and the edit window 1200 are displayed together in a single display.

Thus, Applicants submit that claim 1 is allowable for at least this reason. Additionally, Applicants submit that claims 2-6 and 8-10 are allowable, at least because of their dependency from claim 1.

Regarding claim 12, because this claim recites the same feature discussed above with regard to claim 1, Applicants submit that claim 12 is allowable for at least the same reasons set forth above. Additionally, Applicants submit that claims 12-16 and 18 are allowable at least because of their dependency.

Claim Rejections - 35 U.S.C. § 103(a)

The Examiner rejected claims 7, 11, 17, 19 and 20 under § 103(a) as being unpatentable over Rodriguez as applied to claims 1-6, 8-10, 12-16 and 18 and in further view of Fernandez.

Applicants respectfully submit that because both of these references are deficient for at least the same reasons as set forth in our proposed arguments above, that neither Rodriguez nor Fernandez, either alone or in combination, teach or suggest, at least the features recited in independent claims 1, 12 and 20, namely, displaying both an edit window and a search window together in a single display screen. Thus, Applicants submit that claim 20 is allowable for at

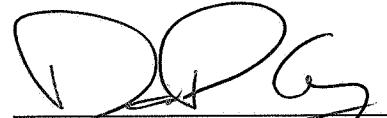
least this reason. Additionally, Applicants submit that claims 7, 11, 17 and 19 are allowable, at least because of their dependency.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



David P. Emery
Registration No. 55,154

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE
23373
CUSTOMER NUMBER

Date: November 21, 2006